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11 Attorneys for Defendant
12 BDO REMIT (USA), INC.

13 **UNITED STATES DISTRICT COURT**
14 **CENTRAL DISTRICT OF CALIFORNIA**
15 **WESTERN DIVISION**

17 STICHTING BDO, a Netherlands
Corporation

18 Plaintiff,

19 v.

20 BDO REMITTANCE (USA), INC., a
21 California Corporation,

22 Defendant.

Case No. CV 10-02925-SVW (CWx)

ANSWER

DEMAND FOR JURY TRIAL

ANSWER

Defendant BDO Remit (USA), Inc. (“Remit”), formerly BDO Remittance (USA), Inc., answers the Plaintiff Stichting BDO’s (“Stichting”) Complaint for Injunctive Relief and Damages (the “Complaint”) as follows:

1. Paragraph 1 of the Complaint contains descriptive matter, argument, and conclusions of law to which no response is required. Remit further states that Stichting’s Complaint in this action speaks for itself. To the extent that a response is required, Remit denies the allegations of Paragraph 1.

2. Remit admits that Stichting has alleged an action for trademark infringement, false designation of origin, trademark dilution, and unfair competition under federal law and the laws of the State of California. Remit denies that the allegations have merit or are sufficiently pleaded, and otherwise denies the allegations of Paragraph 2.

3. Paragraph 3 of the Complaint contains argument and conclusions of law to which no response is required. To the extent that a response is required, Remit denies the allegations of Paragraph 3.

JURISDICTION AND VENUE

4. Remit admits that this Court has jurisdiction over the subject matter of this action and that venue is proper in the Central District of California.

1 5. Remit admits that it is incorporated in California, that this Court has
2 personal jurisdiction over it, and that venue is proper in this District. Remit denies the
3 remaining allegations of Paragraph 5.
4

5 **THE PARTIES**

6 6. Remit is without knowledge or information sufficient to form a belief as
7 to the truth of the allegations of Paragraph 6 and therefore denies the allegations of
8 Paragraph 6.
9

10 7. Remit is without knowledge or information sufficient to form a belief as
11 to the truth of the allegations of Paragraph 7 and therefore denies the allegations of
12 Paragraph 7.
13

14 8. Remit admits that it identifies itself as BDO Remit (USA), Inc., and that
15 BDO Remit (USA), Inc. is a corporation organized under the laws of California and a
16 subsidiary of Banco De Oro, a Philippines-based bank. Remit admits that it provides
17 wire transfer services to the Philippines by individuals and companies owned or
18 operated by Filipinos located in the United States. Remit denies the remaining
19 allegations of Paragraph 8.
20
21

22 9. Remit admits the allegations of Paragraph 9 of the Complaint.
23

24 **FACTS COMMON TO ALL CAUSES OF ACTION**

25 10. Remit admits that Stichting has registered the word mark "BDO" (U.S.
26 Trademark Reg. No. 2,699,803), the word and design mark "BDO" (U.S. Trademark
27
28

1 Reg. No. 2,699,812), and the word mark “BDO International” (U.S. Trademark Reg.
2 No. 2,699,804). Remit is without knowledge or information sufficient to form a belief
3 as to the truth of the remaining allegations of Paragraph 10 and therefore denies the
4 remaining allegations of Paragraph 10.
5

6 11. Remit is without knowledge or information sufficient to form a belief as
7 to the truth of the allegations of Paragraph 11 and therefore denies the allegations of
8 Paragraph 11.
9

10 12. Paragraph 12 of the Complaint contains argument and conclusions of law
11 to which no response is required. To the extent that a response is required, Remit
12 denies the allegations of Paragraph 12.
13

14 13. Remit is without knowledge or information sufficient to form a belief as
15 to the truth of the allegations of Paragraph 13 and therefore denies the allegations of
16 Paragraph 13.
17

18 14. Remit is without knowledge or information sufficient to form a belief as
19 to the truth of the allegations of Paragraph 14 and therefore denies the allegations of
20 Paragraph 14.
21

22 **DEFENDANT BDO REMITTANCE’S ACTS OF INFRINGEMENT**
23

24 15. Remit admits that it provides wire transfer services to the Philippines by
25 individuals and companies owned or operated by Filipinos located in the United States
26
27
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1 and that the name “BDO Remit” is displayed in its own offices. Remit denies the
2 remaining allegations of Paragraph 15.

3
4 16. Remit admits that BDO Remittance (USA), Inc. filed intent-to-use
5 applications in the United States Patent and Trademark Office for the trademarks
6 referenced in Paragraph 16, and that these applications were based not on actual use of
7 these trademarks in the United States, but on an intent to use these marks for wire
8 transfer services to the Philippines by individuals and companies owned or operated
9 by Filipinos located in the United States.
10

11
12 17. Remit admits that its intent-to-use application for “BDO” (application
13 serial number 77/765553) was voluntarily abandoned. Remit denies the remaining
14 allegations of Paragraph 17.
15

16 18. Remit denies the allegations of Paragraph 18 of the Complaint.

17 19. Remit denies the allegations of Paragraph 19 of the Complaint.
18

19 20. Remit admits that it has no connection with Stichting and that Stichting
20 has not authorized, licensed, or otherwise consented to the use by Remit of its
21 federally registered trademarks, but denies that any such consent, license, or
22 authorization is required for its specific wire transfer services to the Philippines.
23

24 21. Remit admits that Stichting has made a written demand to Remit, but
25 otherwise denies the allegations of Paragraph 21.
26
27
28

FIRST CLAIM FOR RELIEF
TRADEMARK INFRINGEMENT PURSUANT TO 15 U.S.C. § 1114

22. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

23. Remit denies the allegations of Paragraph 23 of the Complaint.

24. Paragraph 24 of the Complaint contains argument and conclusions of law to which no response is required. To the extent that a response is required, Remit denies the allegations of Paragraph 24.

25. Remit denies the allegations of Paragraph 25 of the Complaint.

26. Remit denies the allegations of Paragraph 26 of the Complaint.

27. Remit denies the allegations of Paragraph 27 of the Complaint.

SECOND CLAIM FOR RELIEF
FALSE DESIGNATION OF ORIGIN PURSUANT TO 15 U.S.C. § 1125(a)

28. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

29. Remit denies the allegations of Paragraph 29 of the Complaint.

30. Paragraph 30 of the Complaint contains argument and conclusions of law to which no response is required. To the extent that a response is required, Remit denies the allegations of Paragraph 30.

31. Remit denies the allegations of Paragraph 31 of the Complaint.

32. Remit denies the allegations of Paragraph 32 of the Complaint.

33. Remit denies the allegations of Paragraph 33 of the Complaint.

THIRD CLAIM FOR RELIEF

STATE TRADEMARK DILUTION UNDER CA. BUS. & PROF. CODE § 14330

34. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

35. Remit is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 35 and therefore denies the allegations of Paragraph 35.

36. Paragraph 36 of the Complaint contains argument and conclusions of law to which no response is required. To the extent that a response is required, Remit denies the allegations of Paragraph 36.

37. Remit denies the allegations of Paragraph 37 of the Complaint.

FOURTH CLAIM FOR RELIEF

STATE UNFAIR COMPETITION UNDER CA. BUS. & PROF. CODE § 17200

38. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

39. Remit denies the allegations of Paragraph 39 of the Complaint.

40. Remit denies the allegations of Paragraph 40 of the Complaint.

41. Remit denies the allegations of Paragraph 41 of the Complaint.

42. Remit denies the allegations of Paragraph 42 of the Complaint.

FIFTH CLAIM FOR RELIEF
COMMON LAW TRADEMARK INFRINGEMENT

43. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

44. Remit denies the allegations of Paragraph 44 of the Complaint.

45. Remit denies the allegations of Paragraph 45 of the Complaint.

46. Remit denies the allegations of Paragraph 46 of the Complaint.

SIXTH CLAIM FOR RELIEF
COMMON LAW UNFAIR COMPETITION

47. Remit incorporates by reference its answers to the averments of Paragraphs 1 through 21 as if fully set forth herein.

48. Remit denies that it uses “BDO,” “BDO Remittance,” and “BDO Remittance (USA), Inc.,” and further denies the remaining allegations of Paragraph 48 of the Complaint.

49. Remit denies the allegations of Paragraph 49 of the Complaint.

50. Remit denies the allegations of Paragraph 50 of the Complaint.

51. Remit denies the allegations of Paragraph 51 of the Complaint.

52. Remit denies the allegations of Paragraph 52 of the Complaint.

AFFIRMATIVE DEFENSES

Remit states the following separate and distinct affirmative defenses to the allegations in the Complaint, without assuming the burden of proof where such burden

1 is otherwise of Plaintiff as a matter of applicable substantive and procedural law.

2 Remit reserves the right to supplement or amend these defenses.

3
4 **FIRST AFFIRMATIVE DEFENSE**

5 Stichting's claims against Remit must be dismissed because Stichting fails to
6 state a claim upon which relief can be granted. All claims against Remit should be
7 dismissed pursuant to Fed. R. Civ. P. 12(b)(6).
8

9 **SECOND AFFIRMATIVE DEFENSE**

10 Stichting's claims are barred, in whole or in part, by the equitable doctrine of
11 acquiescence in trademark law.
12

13 **THIRD AFFIRMATIVE DEFENSE**

14 Stichting's claims are barred, in whole or in part, by the equitable doctrine of
15 waiver and/or estoppel.
16

17 **FOURTH AFFIRMATIVE DEFENSE**

18 There is no legal or factual basis for awarding increased, exemplary, punitive
19 damages or attorneys' fees and any award of increased, exemplary or punitive
20 damages would be a denial of substantive and procedural due process as guaranteed
21 by the United States Constitution.
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WHEREFORE, Remit demands judgment in its favor dismissing the Complaint in its entirety, awarding to Remit the costs and disbursements incurred in defending this action, and granting such other relief as the Court deems just and proper.

Defendant Remit hereby demands a trial by jury on all issues so triable.

WILMER CUTLER PICKERING
HALE AND DORR LLP

By: /s/ Michael D. Jay
Michael D. Jay

Attorneys for Defendants
BDO REMITTANCE (USA), INC.